

REMARKS

Claims 4 and 6-8 have been canceled. Claims 1-3, 5, and 9-12 remain pending in the application.

Claims 9-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,377,795 to Bach et al. in view of U.S. Patent No. 6,748,068 to Walsh et al., and further in view of U.S. Patent Application Publication No. 2002/01114431 to McBride et al.; claims 1-2 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bach et al. in view of Walsh et al., McBride et al., and further in view of U.S. Patent No. 5,206,900 to Callele; and claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bach et al., Walsh et al., Callele, McBride et al., and further in view of U.S. Patent No. 6,026,152 to Cannon et al.. Applicant respectfully traverses the rejections.

The Examiner conceded that “Bach et al. do not disclose immediately connecting the call without emitting a dial tone if the originating number is not registered in the telephone directory database, and announcing a recorded message.”

The Examiner cited McBride et al. as a new combining reference that allegedly suggests the claimed feature of announcing a prearranged recorded nonsensical message.

As shown by the flowchart in Fig. 10 thereof, McBride et al. describe a technique where it is determined whether or not there is a personal greeting when a call is received; and when there is such a greeting, the personal greeting is played; but when there is no such greeting, a “canned greeting” is announced. In either case, the caller is then prompted to input a passcode for access and connection to the called party. The call is automatically disconnected when an incorrect passcode is repeatedly input or when no passcode is entered. Thus, McBride et al. actually teach away from the claimed feature of immediately connecting a call, as it explicitly describes requiring a passcode before connecting a call. And the cited portions of McBride et al. only include description of playing a “canned greeting” when a

called party has not programmed a personal greeting for the caller of an incoming call. Such portions of McBride et al., therefore, only include description of a “canned greeting” for callers who have not been registered with “custom greetings.” Such portions of McBride et al. do not include any disclosure or suggestion that such a “canned greeting” would be meaningless or nonsensical. Thus, contrary to the Examiner’s assertion, McBride et al. do not suggest a nonsensical message, as claimed.

Applicant reiterates that Walsh et al. explicitly describe handling future calls from particular telemarketers, as assigned by a called user using caller ID information, and showing caller ID information to a called user for first time callers before connecting the received calls. Thus, Walsh et al., as relied upon by the Examiner, clearly do not suggest any consideration for one-time only calls, the purpose of which is to precisely display their caller ID numbers without connecting to the called users to lure them into calling back the caller ID numbers. The cited reference, therefore, clearly does not suggest the need to immediately connect such a one-time call. Indeed, the cited portions of Walsh et al. only include description of showing caller ID to a called user and diverting different calls accordingly before connecting such calls. And, therefore, Walsh et al. do not suggest the claimed feature of immediately connecting a call and announcing a prearranged recorded nonsensical message.

The Examiner cited description in Callele of a disadvantage of conventional answering machines of costing legitimate callers long distance charges without reaching their called parties as alleged suggestion of the claimed feature of immediately connecting a call for imposing a charge. As such, the cited portion of Callele actually teaches away from immediately imposing a call charge since such portion describes it as a disadvantage of conventional answering machines that is to be overcome.

Applicant respectfully submits that the Examiner has failed to establish prima facie obviousness by only relying upon improper hindsight from the claimed invention to combine disparate features of the cited references, which, by themselves, do not suggest the claimed invention or the feature of immediately connecting a call and announcing a prearranged recorded nonsensical message. The cited references, in fact, teach away from the claimed invention because they all consistently describe call diverting features that are performed before received calls are connected, and which are to overcome disadvantages of conventional answering machines that lack such features.

Therefore, even assuming, arguendo, that it would have been obvious to one skilled in the art at the time the claimed invention was made to combine the cited references, such a combination would still have failed to disclose or suggest,

“[a] method for preventing one-time only calls to a portable telephone set, comprising:

retrieving data from a telephone directory database if a call arrives at a portable terminal device, and determining whether an originating number is registered in the telephone directory database; and

immediately connecting the call without emitting a dial tone if the originating number is not registered in the telephone directory database, and announcing a prearranged recorded nonsensical message,” as recited in claim 9. (Emphasis added)

Again, the claimed invention advantageously provides for addressing one-time only calls—where a call is made to a called user and immediately disconnected without call connection charges so that a return caller ID number is added to the called user’s caller ID information. The claimed invention provides for immediately connecting such calls to impose call connection charges to one-time only callers—thus increasing the expenses for such callers who attempt to lure called users to call back the caller ID number and to thereby impose charges on the called users for making such return calls.

Accordingly, Applicant respectfully submits that claim 9, together with claim 10 dependent therefrom, is patentable over the cited references, separately and in combination, for at least the foregoing reasons. Claims 1 and 11 incorporate features that correspond to those of claim 9 cited above, and are, therefore, together with claims 2-3, 5, and 12 dependent therefrom, respectively, patentable over the cited references for at least the same reasons.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

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